



Dkt. No. 60390-AZ-PCT-US/JPW/GJG/NDP

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Arlindo L. Castelhana et al.
Serial No. : 10/816,329 Examiner: T. McKenzie
Filed : March 31, 2004 Group Art Unit: 1624
For : 4-HETEROCYCLO-PYRROLO [2,3d] PYRIMIDINE
COMPOSITIONS AND THEIR USE

1185 Avenue of the Americas
New York, New York 10036
May 16, 2006

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION TO REVIVE AN UNINTENTIONALLY ABANDONED APPLICATION
UNDER 37 C.F.R. §1.137(b)**

This Petition is submitted to revive the above-identified unintentionally abandoned application. A Notice of Abandonment was issued March 17, 2006 indicating that the subject application is abandoned for Applicant's failure to timely file a reply to the Office Action mailed May 17, 2005. A copy of the March 17, 2006 Notice of Abandonment and accompanying Interview Summary is attached as **Exhibit A**. Applicants are filing this Petition promptly after receipt of the March 17, 2006 Notice of Abandonment.

Requirements of Petition to Revive

A petition under 37 C.F.R. §1.137(b) must be accompanied, in relevant part, by:

- (1) the required reply to the May 17, 2005 Office Action;
- (2) the petition fee set forth in 37 C.F.R. §1.17(m);

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Applicants: Arlindo L. Castelhana et al.
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- (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional; and
- (4) any terminal disclaimer (and fee set forth in §120(d)) required pursuant to 37 C.F.R. §1.137(d) for a utility application filed before June 8, 1995.

Required Reply Under 37 C.F.R. §1.137(b)(1)

Applicants attach hereto as **Exhibit G** an Amendment in Response to May 17, 2005 Office Action and Second Supplemental Information Disclosure Statement.

Petition Fee Required Under 37 C.F.R. §1.137(b)(2)

The fee for a Petition under 37 C.F.R. §1.137(b) as set forth in 37 C.F.R. §1.17(m) for a large entity is \$1,500.00 and a check including this amount is enclosed.

Statement that the Entire Delay in Filing the Required Reply was Unintentional Under 37 C.F.R. §1.137(b)(3)

The entire delay in filing the required reply, i.e., from the August 17, 2005 deadline for response to May 17, 2005 Office Action until the filing of this Petition, was unintentional.

The subject application was filed on March 31, 2004 by the undersigned on behalf of OSI Pharmaceuticals, Inc., ("OSI") the owner and assignee of record. Subsequently, OSI informed the undersigned that OSI would handle prosecution of the subject application directly by its in-house attorney, and this transfer of responsibility for the prosecution of the subject application to OSI Pharmaceuticals, Inc. was confirmed

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in a May 20, 2005 letter, a copy of which is attached hereto as **Exhibit B**.

In the meantime, the May 17, 2005 Office Action was mailed by the Patent and Trademark Office to Cooper & Dunham LLP. Upon receipt, the undersigned forwarded the May 17, 2005 Office Action to OSI on May 26, 2005 with a cover letter advising OSI of the deadline for response and confirming the understanding that OSI will prepare and file a response to the May 17, 2005 Office Action. A copy of the May 26, 2005 letter to OSI forwarding the May 17, 2005 Office Action is attached hereto as **Exhibit C**.

On February 1, 2006, Examiner McKenzie called the undersigned to inquire if a response to the May 17, 2005 Office Action had been filed or if the application had been abandoned. Because responsibility for prosecution of the subject application had been transferred to OSI on May 20, 2005, the undersigned did not know the status of the subject application and could not respond to Examiner's inquiry. Instead, the undersigned informed the Examiner that he would forward the inquiry to the appropriate person. Then, by a February 1, 2006 e-mail to Ms. Kimberly T. Nguyen and to Dr. Shu Lee, both of OSI, a copy of which is attached hereto as **Exhibit D**, the undersigned notified OSI of the Examiner's inquiry and requested confirmation that someone will call Examiner McKenzie. On February 1, 2006, Ms. Kimberly T. Nguyen confirmed receipt of the message and stated that she will call Examiner McKenzie, as evident on the attached Exhibit D.

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The undersigned then received the March 17, 2006 Notice of Abandonment. Attached to the March 17, 2006 Notice was an Interview Summary, which stated that during a February 1, 2006 interview between Examiner McKenzie and the undersigned, "[A]pplicants confirmed their intention to abandon this case."

At no time did the undersigned indicate, much less confirm, an intention to abandon the subject application. As explained above, the undersigned referred the Examiner's inquiry to OSI.

On behalf of OSI, Ms. Kimberly T. Nguyen in the Statement attached hereto as **Exhibit E**, states that she inadvertently omitted to call the Examiner. Ms. Nguyen also states that the entire delay in filing the required reply, i.e., from the August 17, 2005 deadline for response to May 17, 2005 Office Action until the filing of this Petition, was unintentional.

Finally, all future correspondence in the subject application should be addressed to Ms. Kimberly T. Nguyen. In this regard, a Revocation of Power of Attorney and Notice of Change of Correspondence Address is being filed concurrently with this Petition and a copy is enclosed as **Exhibit F**.

Terminal Disclaimer Under 37 C.F.R. §1.137(b)(4)

Because the subject application was filed on April 19, 2000, which is after June 8, 1995, a terminal disclaimer is not required under 37 C.F.R. §1.137(d).

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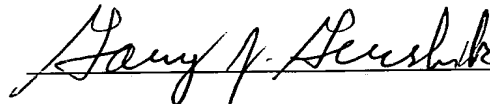
Summary

In view of the foregoing, applicants earnestly solicit an expeditious revival of the subject application so that it may proceed to issue.

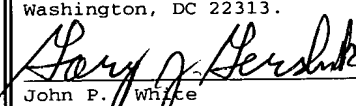
If a telephone interview would be of assistance in resolving any issue in connection with this petition, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee, other than the enclosed \$1,500.00 petition fee as set forth in 37 C.F.R. §1.17(m), is deemed necessary in connection with the filing of this Petition. However, if any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



John P. White
Registration No. 28,678
Gary J. Gershik
Registration No. 39,992
Attorneys for Applicants
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
(212) 278-0400

| | |
|---|---------|
| I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents Washington, DC 22313. | |
|  | 5/16/06 |
| John P. White | Date |
| Reg. No. 28,678 | |
| Gary J. Gershik | |
| Reg. No. 39,992 | |

COOPER & DUNHAM LLP

ATTORNEYS AT LAW

1185 AVENUE OF THE AMERICAS, NEW YORK, NEW YORK 10036

TELEPHONE: (212) 278-0400

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| ROBERT D. KATZ | PETER J. PHILLIPS |
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| ARIAN A. BARYALAI | AUDE GERSPACHER |
| ASHTON J. DELAUNEY | JEFFREY C. SHIEH |
| CINDY YANG | NARESH SRITHARAN |
| BRIAN J. AMOS | DAVID J. KERWICK |
| JOSEPH B. GROSS | TONIA A. SAYOUR |
| DANIEL N. SMITH | LESLIE K. NGUYEN* |
| KATHARINE R. RICE* | NILAY D. PATEL* |

FACSIMILE: (212) 391-0525
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(212) 391-0630

OF COUNSEL
DONALD S. DOWDEN
PEDRO C. FERNANDEZ

FOUNDED 1887
www.cooperdunham.com

May 20, 2005

*NEW YORK STATE BAR ADMISSION PENDING

BY FEDERAL EXPRESS

Ms. Kim Nguyen
Patent Agent
OSI Pharmaceuticals, Inc.
58 South Service Road
Melville, NY 11747

Re: Transfer to OSI Pharmaceuticals, Inc. of files in the
60390, 60391, 66449 and 66450 Series

Dear Kim:

In accordance with your March 24, 2005 e-mail, we are forwarding to you with this letter five (5) boxes containing copies of our files in our docket series "60390," "60391," "66449" and "66450". As we agreed during our April 12, 2005 telephone conference, we are not enclosing copies of the file history of any U.S. patent or U.S. application whose file history is available on the public "PAIR" system of the U.S. Patent and Trademark Office.

We are also currently notifying the foreign associate handling each non-U.S. patent and patent application to directly correspond with you in the future and to continue to use our Docket number for reference. We trust that you will shortly file the appropriate documents with the U.S. Patent and Trademark Office in connection with each U.S. patent and pending U.S. patent application notifying the U.S. Patent and Trademark Office of the correspondence address change.

For your convenience, we also enclose a table entitled "Table of Dockets to be Transferred May 20, 2005 to OSI: 60390, 60391, 66449 and 66450" setting forth, in order of docket number, all files provided herewith, and where applicable, any outstanding actions

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Ms. Kim Nguyen
May 20, 2005
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and their due dates. While measures have been taken to ensure the accuracy of the enclosed table, this table is provided solely for your convenience and should not be relied upon in determining any action required or the deadline for taking such action in connection with the enclosed files.

We understand that, effective immediately, OSI Pharmaceuticals, Inc. will assume responsibility for all cases in the above-identified series except that we will prepare and file one more reply in two cases, namely in our Docket 60390-G and 66449-A. All responses thereafter will be the responsibility of OSI Pharmaceuticals, Inc.

Furthermore, as you requested during our April 12, 2005 telephone conference, we will continue to monitor all foreign annuity deadlines for the patents and application until we receive contrary instructions from OSI Pharmaceuticals, Inc. In this regard, please notify us of any change in the status of any of the pending applications. In particular, notify us once a patent is granted, so that we can update our records.

We will also monitor and forward reminders to you concerning the deadline for paying, but are not to pay, the maintenance fees for issued U.S. Patents in the above-identified series. We understand that the preceding will be the procedure in effect unless and until you instruct us otherwise.

In the interest of clarity, we have identified four categories of files on the attached schedule and will monitor them as follows:

A - U.S. Patents

We will monitor all U.S. patents listed on the attached table and send you reminders of deadlines for payment of maintenance fees, but we will not pay such fees on your behalf.

B - U.S. Patent Applications

No maintenance fees are due in connection with U.S. applications. If you would like us to monitor maintenance fees for any U.S. patent issued in the future, we would be able to do so on a case-by-case basis, provided that you forward to us the number of the patent and the date each such patent is issued.

Ms. Kim Nguyen
May 20, 2005
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C - Non-U.S. Patents

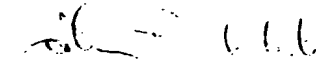
We will monitor using Dennemeyer Annuity Service the annuity deadlines for all non-U.S. patents listed on the attached table.

D - Non-U.S. Applications

We will monitor using Dennemeyer Annuity Service the annuity deadlines for all non-U.S. applications listed on the attached table inasmuch as the patents have not yet been issued. If you would like us to monitor annuities for any non-U.S. patent granted after the date of this letter from any such application, we would be able to do so on a case-by-case basis, provided that you forward to us the number of the patent and the date each such patent is granted.

If you have any questions, please contact Gary Gershik or me.

Sincerely,



John P. White

JPW/GJG/NDP
Enclosures

COOPER & DUNHAM LLP

ATTORNEYS AT LAW

1185 AVENUE OF THE AMERICAS, NEW YORK, NEW YORK 10036

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OF COUNSEL
DONALD S. DOWDEN
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May 26, 2005

*NEW YORK STATE BAR ADMISSION PENDING

BY MAIL

Ms. Kim Nguyen
OSI Pharmaceuticals, Inc.
Suite 110
58 South Service Rd.
Melville, NY 11747

Re: Arlindo L. Castelhana et al., Pyrrolo [2,3d] Pyrimidine Compositions And Their Use, U.S. Serial 10/816,329, filed March 31, 2004 Divisional of U.S. Serial No. 09/728,229, filed December 1, 2000, which is a continuation of PCT International Application No. PCT/US99/12135, filed June 1, 1999, on behalf of OSI Pharmaceuticals, Inc., claiming priority of U.S. Provisional Application No. 60/087,702, filed June 2, 1998, U.S. Provisional Application No. 123,216, filed March 8, 1999 and U.S. Provisional Application No. 60/126,527, filed March 26, 1999 - Our Docket 60390-AZ-PCT-US

Dear Kim:

Further to our March 24, 2005 letter, we enclose a copy of a May 17, 2005 Office Action issued by the U.S. Patent and Trademark Office in connection with the above-identified application. A response to the Office Action is due August 17, 2005, which deadline is extendible.

In accordance with our May 20, 2005 letter and in the absence of your contrary instructions, we understand that you will prepare and file a response to the May 17, 2005 Office Action, thus we will not take any further action in connection with the subject application.

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Exhibit C

Ms. Kim Nguyen
May 26, 2005
Page 2

Please contact John White or me if you have any questions, comments or special instructions.

Sincerely,

Gary J. Gershik

JPW/GJG/NDP
Enclosure

cc: John P. White (w/o enclosure)

Gary J. Gershik

From: Nguyen, Kimberly [KNguyen@OSIP.com]
Sent: Wednesday, February 01, 2006 1:32 PM
To: Gary J. Gershik
Cc: Lee, Shu
Subject: RE: 60390-AZ-PCT-US

Will do. Thanks Gary.

-----Original Message-----

From: Gary J. Gershik [mailto:GGERSHIK@COOPERDUNHAM.COM]
Sent: Wednesday, February 01, 2006 1:30 PM
To: Nguyen, Kimberly
Cc: Lee, Shu
Subject: 60390-AZ-PCT-US

Dear Kim,

Examiner McKenzie called me to inquire if a response has been filed in the referenced case or if the case is abandoned. He requested a call back with the answer at 571-272-0670.

Please confirm that you will call the Examiner and take care of what needs to be done.

Best regards,

Gary J. Gershik
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
T: 212-278-0400 F: 212-391-0525

The contents of this message, together with any attachments, are intended only for the use of the individual or entity to which they are addressed and may contain information that is legally privileged, confidential and exempt from disclosure. If you are not the intended recipient, you are hereby notified that any dissemination, distribution, or copying of this message, or any attachment, is strictly prohibited. If you have received this message in error, please notify the original sender immediately by telephone or by return E-mail and delete this message, along with any attachments, from your computer. Thank you.

2/1/2006

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Filed: March 31, 2004
Exhibit D

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Arlindo L. Castelhana et al.
Serial No. : 10/816,329 Examiner: T. McKenzie
Filed : March 31, 2004 Group Art Unit: 1624
For : 4-HETEROCYCLO-PYRROLO [2,3d] PYRIMIDINE
COMPOSITIONS AND THEIR USE

1185 Avenue of the Americas
New York, New York 10036

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

STATEMENT UNDER 37 C.F.R. §1.137(b)(3)

- 1) I, Kimberly T. Nguyen, am a Patent Agent employed by OSI Pharmaceuticals, Inc. ("OSI"), the owner and assignee of the above-identified application.
- 2) Responsibility for the prosecution of the above-identified application was assigned to me beginning May 20, 2005.
- 3) I received a copy of the May 17, 2005 Office Action in connection with the subject application along with a May 26, 2005 letter from Mr. Gary J. Gershik of Cooper & Dunham LLP.
- 4) On February 1, 2006 Mr. Gershik informed me that Examiner McKenzie has inquired whether a response had been filed to the May 17, 2005 Office Action and requested that I call Examiner McKenzie with a reply.

Applicants: Arlindo L. Castelhana et al.
Serial No.: 10/816,329
Filed: March 31, 2004
Exhibit E

Applicants: Arlindo L. Castelhana et al.

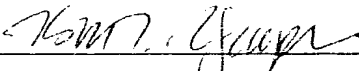
Serial No.: 10/816,329

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- 5) I inadvertently omitted to call Examiner McKenzie with a reply.
- 6) The entire delay in filing the required reply, i.e., from the August 17, 2005 deadline for response to May 17, 2005 Office Action until the filing of the accompanying Petition to Revive an Unintentionally Abandoned Application under 37 C.F.R. §1.137(b), was unintentional.

Respectfully submitted,


Ms. Kimberly T. Nguyen

May 15, 2006
Date

Registration No. 47,821
OSI Pharmaceuticals, Inc.
41 Pinelawn Rd.
Melville, NY 11747
(631) 962-2000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Arlindo L. Castelhana et al.
Serial No. : 10/816,329 Examiner: T. McKenzie
Filed : March 31, 2004 Group Art Unit: 1624
For : 4-HETEROCYCLO-PYRROLO [2,3d] PYRIMIDINE
COMPOSITIONS AND THEIR USE

1185 Avenue of the Americas
New York, New York 10036

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**REVOCATION OF POWER OF ATTORNEY AND APPOINTMENT OF NEW
ATTORNEYS AND NOTICE OF CHANGE OF ADDRESS**

OSI PHARMACEUTICALS, INC., the assignee of the above-identified application by virtue of an assignment from Arlindo L. Castelhana, Bryan McKibben and David J. Witter, recorded with the United States Patent and Trademark Office on March 26, 2001 at Reel 011704, Frames 0888-0892, a copy of which is attached hereto as **Exhibit 1**, hereby revokes all powers of attorney previously granted and appoints the following attorneys: Shu M. Lee (Reg. No. 41,147) and Kimberly T. Nguyen (Reg. No. 47,824); and each of them, all c/o OSI Pharmaceuticals, Inc., 41 Pinelawn Rd., Melville, New York 11747, its attorneys, each with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to receive the patent, to transfer all business in the U.S. Patent and Trademark Office connected therewith and to file any International Applications which are based thereon under the provisions of the Patent Cooperation Treaty.

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Applicants: Arlindo L. Castelhana et al.
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Please address all communications and direct all telephone calls regarding this application to:

MS. KIMBERLY T. NGUYEN
OSI PHARMACEUTICALS, INC.
41 PINELAWN RD
MELVILLE, NY 11747
TEL. (631) 962-2000

I certify that I am authorized to sign this Revocation of Power of Attorney on behalf of OSI PHARMACEUTICALS, INC.

OSI PHARMACEUTICALS, INC.

by: Barbara A. Wood Date: May 15, 2006
Barbara A. Wood, Esq.
Vice President and General Counsel
41 Pinelawn Rd.
Melville, NY 11747
United States of America
Assignee of Record